



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Jenuwein *et al.*

Appl. No.: 10/773,302

Filed: February 9, 2004

For: **Chromatin Regulator Genes**

Confirmation No.: 8734

Art Unit: 1651

Examiner: *To Be Assigned*

Atty. Docket: 0652.1670002/JUK/JCI

Information Disclosure Statement Under 37 C.F.R. § 1.97(b)

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. Copies of U.S. patents and patent application publications cited on the attached Form PTO-1449 are not submitted in accordance with 1276 OG 55 because this application was filed after June 30, 2003. Copies of documents AL1 to AL2 and AR1 to AR66 are provided.

In accordance with 37 C.F.R. § 1.98(a)(3), Applicants' undersigned representative submits the following discussion of the relevance of the non-English language document AM1 cited on Form PTO 1449:

Document AM1, DE 195 16 776, is in the German language. An English language abstract of document AM1 is attached as document AT65.

The Examiner's attention is directed to the following co-pending applications which are directed to related technical subject matter:

U.S. Application No. 09/500,991, Uhlmann *et al.*, filed February 15, 2000,
now pending, and submitted herewith as document AR65;

U.S. Application No. 09/876,224, Jenuwein *et al.*, filed June 8, 2001, now
published as U.S. Patent Application Publication No. 2002/0039776 A1, and listed as
document AD1;

U.S. Application No. 10/051,311, Peters *et al.*, filed January 22, 2002,
now published as U.S. Patent Application Publication No. 2002/0164620 A1, and listed
as document AE1;

U.S. Application No. 10/302,904, Jenuwein *et al.*, filed November 25, 2002,
now published as U.S. Patent Application Publication No. 2003/0104599 A1, and listed as
document AG1;

U.S. Application No. 10/323,968, Jenuwein *et al.*, filed December 20, 2002,
now published as U.S. Patent Application Publication No. 2003/0157532 A1, and listed as
document AH1.

The identification of these U.S. Patent Applications is not to be construed as a
waiver of secrecy as to those applications now or upon issuance of the present application
as a patent. The Examiner is respectfully requested to consider the cited applications and
the art cited therein during examination.

Applicants would like to bring to the Examiner's attention document AT59,
Wreggett, K.A. *et al.*, for which Applicants were unable to determine the month of

publication. Applicants would also like to bring to the Examiner's attention document AT27, Jolley, M.E., for which Applicants were unable to determine the exact month of publication.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Judith U. Kim
Attorney for Applicants
Registration No. 40,679

Date: November 23, 2004

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Washington, D.C. 20005-3934
(202) 371-2600

FORM PTO-1449 INFORMATION DISCLOSURE STATEMENT	ATTY. DOCKET NO. 0652.1670002/JUK/JCI	APPLICATION NO. 10/773,302
	FIRST NAMED INVENTOR Jenuwein <i>et al.</i>	
	FILING DATE February 9, 2004	ART UNIT 1651

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB-CLASS	FILING DATE
	AA1	5,972,608	10/26/1999	Peterson <i>et al.</i>			08/27/1997
	AB1	6,555,329 B2	04/29/2003	Jenuwein <i>et al.</i>			06/08/2001
	AC1	6,689,583 B1	02/10/2004	Jenuwein <i>et al.</i>			06/09/2000
	AD1	2002/0039776 A1	04/04/2002	Jenuwein <i>et al.</i>			06/08/2001
	AE1	2002/0164620 A1	11/07/2002	Peters <i>et al.</i>			01/22/2002
	AF1	2003/0087368 A1	05/08/2003	Maupin-Furlow <i>et al.</i>			04/30/2002
	AG1	2003/0104599 A1	06/05/2003	Jenuwein <i>et al.</i>			11/25/2002
	AH1	2003/0157532 A1	08/21/2003	Jenuwein <i>et al.</i>			12/20/2002
	AI						
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FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL1	WO 95/15749	06/15/1995	WIPO			Yes No
	AM1	DE 195 16 776	11/14/1996	Germany			X Yes No
	AN1	WO 98/27994	07/02/1998	WIPO			Yes No
	AO1	WO 98/49190	11/05/1998	WIPO			Yes No
	AP1	WO 00/48627	08/24/2000	WIPO			Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	1	Aagaard, L., <i>et al.</i> , "Functional mammalian homologues of the <i>Drosophila</i> PEV-modifier <i>Su(var)3-9</i> encode centromere-associated proteins which complex with the heterochromatin component M31," <i>EMBO J.</i> 18:1923-1938, Oxford University Press (April 1999)
AS	1	Aagaard, L., <i>et al.</i> , "Mitotic phosphorylation of SUV39H1, a novel component of active centromeres, coincides with transient accumulation at mammalian centromeres," <i>J. Cell Sci.</i> 113:817-829, The Company of Biologists Ltd. (March 2000; Published on the WWW on 14 February 2000)
AT	1	Aasland, R. and Stewart, A.F., "The chromo shadow domain, a second chromo domain in heterochromatin-binding protein 1, HP1," <i>Nucleic Acids Res.</i> 23:3168-3173, Oxford University Press (August 1995)

EXAMINER

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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

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EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB-CLASS	TRANSLATION
	AL2	EP 1 227 160 A1	07/31/2002	WIPO			Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>2</u>	Adams, B., <i>et al.</i> , "Pax-5 encodes the transcription factor BSAP and is expressed in B lymphocytes, the developing CNS, and adult testis," <i>Genes & Dev.</i> 6:1589-1607, Cold Spring Harbor Laboratory Press (1992)
AS	<u>2</u>	Adams, R.R., <i>et al.</i> , "INCENP binds the Aurora-related kinase AIRK2 and is required to target it to chromosomes, the central spindle and cleavage furrow," <i>Curr. Biol.</i> 10:1075-1078, Elsevier Science Ltd. (September 2000)
AT	<u>2</u>	Ainsztein, A.M., <i>et al.</i> , "INCENP Centromere and Spindle Targeting: Identification of Essential Conserved Motifs and Involvement of Heterochromatin Protein HP1," <i>J. Cell Biol.</i> 143:1763-1774, The Rockefeller University Press (December 1998)

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	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)			
	AR	<u>3</u>	Alkema, M.J., <i>et al.</i> , "Transformation of axial skeleton due to overexpression of <i>bmi-1</i> in transgenic mice," <i>Nature</i> 374:724-727, Nature Publishing Group (April 1995)
	AS	<u>3</u>	Allshire, R.C., <i>et al.</i> , "Mutations derepressing silent centromeric domains in fission yeast disrupt chromosome segregation," <i>Genes & Dev.</i> 9:218-233, Cold Spring Harbor Laboratory Press (January 1995)
	AT	<u>3</u>	Altschul, S.F., <i>et al.</i> , "Gapped BLAST and PSI-BLAST: a new generation of protein database search programs," <i>Nucl. Acids Res.</i> 25:3389-3402, Oxford University Press (September 1997)

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	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>4</u>	Ambrose, W.P., <i>et al.</i> , "Detection System for Reaction-Rate Analysis in a Low-Volume Proteinase-Inhibition Assay," <i>Anal. Biochem.</i> 263:150-157, Academic Press (1998)
	AS	<u>4</u>	Baksa, K., <i>et al.</i> , "Mutations in the Protein Phosphatase 1 Gene at 87B Can Differentially Affect Suppression of Position-Effect Variegation and Mitosis in <i>Drosophila melanogaster</i> ," <i>Genet.</i> 135:117-125, The Genetics Society of America (1993)
	AT	<u>4</u>	Ball, L.J., <i>et al.</i> , "Structure of the chromatin binding (chromo) domain from mouse modifier protein 1," <i>EMBO J.</i> 16:2473-2481, Oxford University Press (May 1997)

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	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)			
	AR	<u>5</u>	Bannister, A.J., <i>et al.</i> , "Selective recognition of methylated lysine 9 on histone H3 by the HP1 chromo domain," <i>Nature</i> 410:120-124, Nature Publishing Group (March 2001)
	AS	<u>5</u>	Barrett, A.J. and Kirschke, H., "Cathepsin B, Cathepsin H, and Cathepsin L," <i>Methods Enzym.</i> 80:535-561, Academic Press (1981)
	AT	<u>5</u>	Bassett, D.E., Jr., <i>et al.</i> , "Comparative genomics, genome cross-referencing and XREFdb," <i>Trends Genet.</i> 11:372-373, Elsevier Science Ltd. (September 1995)

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	AN						Yes No
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	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)			
	AR	<u>6</u>	Baudat, F., <i>et al.</i> , "Chromosome Synapsis Defects and Sexually Dimorphic Meiotic Progression in Mice Lacking Spo11" <i>Mol. Cell.</i> 6:989-998, Cell Press (November 2000)
	AS	<u>6</u>	Bernard, P., <i>et al.</i> , "Fission Yeast Bub1 is a Mitotic Centromere Protein Essential for the Spindle Checkpoint and the Preservation of Correct Ploidy through Mitosis," <i>J. Cell Biol.</i> 143:1775-1787, The Rockefeller University Press (December 1998)
	AT	<u>6</u>	Boulianne, G.L., <i>et al.</i> , "Production of functional chimaeric mouse/human antibody," <i>Nature</i> 312:643-646, Macmillan Magazines Ltd. (1984)

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	AR	<u>7</u>	Brown, A.M., <i>et al.</i> , "Biotinylated and Cysteine-Modified Peptides as Useful Reagents for Studying the Inhibition of Cathepsin G," <i>Anal. Biochem.</i> 217:139-147, Academic Press, Inc. (February 1994)
	AS	<u>7</u>	Brunk, B.P., <i>et al.</i> , "Drosophila genes <i>Posterior Sex Combs</i> and <i>Suppressor two of zeste</i> encode proteins with homology to the murine <i>bmi-1</i> oncogene," <i>Nature</i> 353:351-353, Nature Publishing Group (1991)
	AT	<u>7</u>	Buck, S.W. and Shore, D., "Action of a RAP1 carboxy-terminal silencing domain reveals an underlying competition between <i>HMR</i> and telomeres in yeast," <i>Genes & Dev.</i> 9:370-384, Cold Spring Harbor Laboratory Press (February 1995)

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							Yes
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	AM						No
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	AN						No
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	AO						No
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	AP						No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	8	Bunick, D., <i>et al.</i> , "Transcription of the testis-specific mouse protamine 2 gene in a homologous <i>in vitro</i> transcription system," <i>Proc. Natl. Acad. Sci. USA</i> , 87: 891-895, National Academy of Sciences (1990)
	AS	8	Buonomo, S.B.C., <i>et al.</i> , "Disjunction of Homologous Chromosomes in Meiosis I Depends on Proteolytic Cleavage of the Meiotic Cohesin Rec8 by Separin," <i>Cell</i> 103:387-398, Cell Press (October 2000)
	AT	8	Burgoyne, P.S., "Genetic Homology and Crossing Over in the X and Y Chromosomes of Mammals," <i>Hum. Genet.</i> 61:85-90, Springer-Verlag (1982)

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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>9</u>	Cai, J. <i>et al.</i> , "Reconstitution of human replication factor C from its five subunits in baculovirus-infected insect cells," <i>Proc. Natl. Acad. Sci. USA</i> 93:12896-12901, National Academy of Sciences (November 1996)
	AS	<u>9</u>	Calenda, A., <i>et al.</i> , "The meiosis-specific <i>Xmr</i> gene product is homologous to the lymphocyte Xlr protein and is a component of the XY body," <i>EMBO J.</i> 13:100-109, Oxford University Press (January 1994)
	AT	<u>9</u>	Cerretani, M., <i>et al.</i> , "A High-Throughput Radiometric Assay for Hepatitis C Virus NS3 Protease," <i>Anal. Biochem.</i> 266:192-197, Academic Press (January 1999)

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OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>10</u>	Chen, D., <i>et al.</i> , "Regulation of Transcription by a Protein Methyltransferase," <i>Science</i> 284:2174-2177, American Association for the Advancement of Science (June 1999)
	AS	<u>10</u>	Ciosk, R., <i>et al.</i> , "An ESP1/PDS1 Complex Regulates Loss of Sister Chromatid Cohesion at the Metaphase to Anaphase Transition in Yeast," <i>Cell</i> 93:1067-1076, Cell Press (June 1998)
	AT	<u>10</u>	Clark, D.A., <i>et al.</i> , "Protease Inhibitors Suppress In Vitro Growth of Human Small Cell Lung Cancer," <i>Peptides</i> 14:1021-1028, Pergamon Press, Ltd. (1993)

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	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

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	AR	<u>11</u>	Cléard, F. <i>et al.</i> , "SU(VAR) 3-7, a <i>Drosophila</i> heterochromatin-associated protein and companion of HP1 in the genomic silencing of position-effect variegation," <i>The EMBO Journal</i> 16:5280-5288, Oxford University Press (September 1997)
	AS	<u>11</u>	Cobb, J., <i>et al.</i> , "Meiotic events at the centromeric heterochromatin: histone H3 phosphorylation, topoisomerase II α localization and chromosome condensation," <i>Chromosoma</i> 108:412-425, Springer-Verlag (December 1999)
	AT	<u>11</u>	Cohen-Fix, O. <i>et al.</i> , "Anaphase initiation in <i>Saccharomyces cerevisiae</i> is controlled by the APC-dependent degradation of the anaphase inhibitor Pds1p," <i>Genes & Dev.</i> 10:3081-3093, Cold Spring Harbor Laboratory Press (December 1996)

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	AN						Yes No
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	AR	<u>12</u>	Cortez, D. and Elledge, S.J., "Conducting the mitotic symphony," <i>Nature</i> 406:354-356, Nature Publishing Group (July 2000)
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	AT	<u>18</u>	Friedman, L.S., <i>et al.</i> , "22 Genes from Chromosome 17q21: Cloning, Sequencing, and Characterization of Mutations in Breast Cancer Families and Tumors," <i>Genomics</i> 25:256-263, Academic Press (January 1995)

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	AR	<u>19</u>	Funabiki, H., <i>et al.</i> , "Cut2 proteolysis required for sister-chromatid separation in fission yeast," <i>Nature</i> 381:438-441, Nature Publishing Company (May 1996)
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	AR	<u>20</u>	Geraghty, M.T., <i>et al.</i> , "The Isolation of cDNAs from OATL1 at Xp11.2 Using a 480-kb YAC," <i>Genomics</i> 16:440-446, Academic Press, Inc. (1993)
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	AT	<u>21</u>	Gray, N.M., <i>et al.</i> , "Discovery and Analysis of a Series of C ₂ -Symmetric HIV-1 Proteinase Inhibitors Derived from Penicillin," <i>Anal. Biochem.</i> 216:89-96, Academic Press (January 1994)

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	AT	<u>25</u>	Hobert, O., <i>et al.</i> , "Interaction of Vav with ENX-1, a Putative Transcriptional Regulator of Homeobox Gene Expression," <i>Mol. Cell. Biol.</i> 16:3066-3073, American Society for Microbiology (June 1996)				

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	AM						Yes No
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	AL2						Yes No
	AM2						Yes No
	AN2						Yes No
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OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

AR	<u>39</u>	Merdes, A. and De Mey, J., "The mechanism of kinetochore-spindle attachment and polewards movement analyzed in PtK ₂ cells at the prophase-prometaphase transition," <i>Eur. J. Cell Biol.</i> 53:313-325, Wissenschaftliche verlagsgesellschaft mbH (1990)
AS	<u>39</u>	Messmer, S., <i>et al.</i> , "Analysis of the functional role of the <i>Polycomb</i> chromo domain in <i>Drosophila melanogaster</i> ," <i>Genes & Dev.</i> 6:1241-1254, Cold Spring Harbor Laboratory Press (1992)
AT	<u>39</u>	Michaelis, C., <i>et al.</i> , "Cohesions: Chromosomal Proteins that Prevent Premature Separation of Sister Chromatids," <i>Cell</i> 91:35-45, Cell Press (October 1997)

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FORM PTO-1449

INFORMATION DISCLOSURE STATEMENT

ATTY. DOCKET NO.
0652.1670002/JUK/JCI

FIRST NAMED INVENTOR
Jenuwein *et al.*

FILING DATE
February 9, 2004

APPLICATION NO.
10/773,302

ART UNIT
1651

U.S. PATENT DOCUMENTS

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	AR	<u>40</u>	Milner, C.M., and Campbell, R.D., "The G9a gene in the human major histocompatibility complex encodes a novel protein containing ankyrin-like repeats," <i>Biochem. J.</i> 290:811-818, Biochemical Society/Portland Press (1993)
	AS	<u>40</u>	Miyazaki, W.Y. and Orr-Weaver, T.L., "Sister-Chromatid Cohesion in Mitosis and Meiosis," <i>Annu. Rev. Genet.</i> 28:167-187, Annual Reviews (December 1994)
	AT	<u>40</u>	Moens, P.B., "Histones H1 and H4 of surface-spread meiotic chromosomes," <i>Chromosoma</i> 104:169-174, Springer-Verlag (November 1995)

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	AR	<u>41</u>	Moore, D.P., <i>et al.</i> , "The Cohesion Protein MEI-S332 Localizes to Condensed Meiotic and Mitotic Centromeres until Sister Chromatids Separate," <i>J. Cell. Biol.</i> 140:1003-1012, The Rockefeller University Press (March 1998)
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AR	<u>42</u>	Murray, M.G., <i>et al.</i> , "Inactivation of a yeast transactivator by the fused HIV-1 proteinase: a simple assay for inhibitors of the viral enzyme activity," <i>Gene</i> 134:123-128, Elsevier Science Publishers B.V. (1993)
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AR	<u>43</u>	Nasmyth, K., <i>et al.</i> , "Splitting the Chromosome: Cutting the Ties That Bind Sister Chromatids," <i>Science</i> 288:1379-1384, The American Association for the Advancement of Science (May 2000)
AS	<u>43</u>	Neuberger, M.S., <i>et al.</i> , "Recombinant antibodies possessing novel effector functions," <i>Nature</i> 312:604-608, Macmillan Magazines Ltd. (1984)
AT	<u>43</u>	Nicholson, D.W., <i>et al.</i> , "Identification and inhibition of the ICE/CED-3 protease necessary for mammalian apoptosis," <i>Nature</i> 376:37-43, Nature Publishing Company (July 1995)

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	AR	<u>45</u>	Pandita, T.K., <i>et al.</i> , "Atm Inactivation Results in Aberrant Telomere Clustering during Meiotic Prophase," <i>Mol. Cell. Biol.</i> 19:5096-5105, American Society for Microbiology (July 1999)
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	AR	<u>46</u>	Paro, R. and Harte, P.J., "The Role of Polycomb Group and Trithorax Group Chromatin Complexes in the Maintenance of Determined Cell States," in <i>Epigenetic Mechanisms of Gene Regulation</i> , Russo, V.E.A., <i>et al.</i> , eds., Cold Spring Harbor Laboratory Press, Plainview, N.Y., pp. 507-528 (December 1996)
	AS	<u>46</u>	Paro, R. and Hogness, D.S. "The Polycomb protein shares a homologous domain with a heterochromatin-associated protein of <i>Drosophila</i> ," <i>Proc. Natl. Acad. Sci. USA</i> 88:263-267, National Academy of Sciences (1991)
	AT	<u>46</u>	Pehrson, J.R. and Fried, V.A., "MacroH2A, a Core Histone Containing a Large Nonhistone Region," <i>Science</i> 257:1398-1400, American Association for the Advancement of Science (1992)

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AR	<u>47</u>	Peters, A.H.F.M., <i>et al.</i> , "A drying-down technique for the spreading of mammalian meiocytes from the male and female germline," <i>Chromosome Res.</i> 5:66-68, Rapid Science Publishers (February 1997)
AS	<u>47</u>	Peters, A.H.F.M., <i>et al.</i> , "Meiosis in carriers of heteromorphic bivalents: sex differences and implications for male fertility," <i>Chromosome Res.</i> 5:313-324, Rapid Science Publishers (August 1997)
AT	<u>47</u>	Peters, J. -M., "SCF and APC: the Yin and Yang of cell cycle regulated proteolysis," <i>Curr. Opin. Cell Biol.</i> 10:759-768, Current Biology Ltd. (December 1998)

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	AR	<u>48</u>	Platero, J.S., <i>et al.</i> , "Functional analysis of the chromo domain HP1," <i>EMBO J.</i> 14:3977-3986, Oxford University Press (August 1995)
	AS	<u>48</u>	Rastelli, L., <i>et al.</i> , "Related chromosome binding sites for zeste, suppressors of zeste and Polycomb group proteins in <i>Drosophila</i> and their dependence on <i>Enhancer of zeste</i> function," <i>EMBO J.</i> 12:1513-1522, Oxford University Press (1993)
	AT	<u>48</u>	Rea, S., <i>et al.</i> , "Regulation of chromatin structure by site-specific histone H3 methyltransferases," <i>Nature</i> 406:593-599, Nature Publishing Company (August 2000)

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	AS	<u>50</u>	Sarubbi, E., <i>et al.</i> , "A high throughput assay for inhibitors of HIV-1 protease. Screening of microbial metabolites," <i>FEBS</i> 279:265-269, Elsevier Science Publishers B.V. (1991)
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	AT	<u>52</u>	Stassen, M.J., <i>et al.</i> , "The <i>Drosophila trithorax</i> proteins contain a novel variant of the nuclear receptor type DNA binding domain and an ancient conserved motif found in other chromosomal proteins," <i>Mech. Dev.</i> 52:209-223, Elsevier Science Ireland Ltd. (August 1995)

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